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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAKOTO TOMIOKA and HIROSHI TSUYUKI

Appeal 2009-003655
Application 09/893,677
Technology Center 2600

Before KENNETH W. HAIRSTON, JOHN C. MARTIN, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants have filed a Request for Rehearing on June 1, 2010 (“Request”) under 37 C.F.R. § 41.52 of the “New Decision on Appeal” dated March 24, 2010 (“Decision”). Specifically, Appellants request rehearing of the panel’s:

(1) affirmance of the Examiner’s rejection of claims 1 and 6-18 under 35 U.S.C. § 103(a) for obviousness over Igarashi ‘232² in view of Takahashi³ (Decision 5, 11);

(2) affirmance of the Examiner’s rejection of dependent claims 2-5 under § 103(a) for obviousness over Igarashi ‘232 and Takahashi and Igarashi ‘634⁴ (*id.* at 5, 12); and

(3) entry of a new ground of rejection of claim 1 under 35 U.S.C. § 103(a) for obviousness over Takahashi considered with or without Igarashi ‘232 (*id.* at 12-20).

A. *Discussion of Appellants’ arguments regarding the affirmed rejections*

In rejecting claims 1 and 6-18 for obviousness over Igarashi ‘232 in view of Takahashi, the Examiner relies on Figures 1 and 2 of Takahashi. (Final Action 4.) Our decision affirming the rejection is based on Takahashi’s Figure 2 rather than Figure 1. (Decision 9.) Regarding our

² Igarashi U.S. Patent 5,902,232, issued May 11, 1999.

³ Takahashi et al. U.S. Patent 5,588,948, issued Dec. 31, 1996.

⁴ Igarashi U.S. Patent 5,954,634, issued Sep. 21, 1999.

reliance on Figure 2, Appellants argue that in affirming the Examiner's rejection,

the BPAI completely ignores Appellants['] . . . argument with regard to the disclosure of Fig. 2 of Takahashi, namely, that even if the last lens included in bracket 6 (relay lens section) is located inside operating/holding section 3, Takahashi still fails to disclose or fairly suggest the feature of claim 1 regarding *the relayed image is formed between the relay optical system and the imaging optical system in the camera head*. (Reply Brief 8 [sic: Br.⁵ 8]).

It is submitted that this is exactly what was argued during the Oral Hearing, specifically, from page 2, line 10 through page 3, line 25 of the transcript of the Oral Hearing[.]

(Request 3.)

Appellants' reliance on the Brief and the oral hearing is misplaced. The argument presented in the Brief regarding the location of the relayed image is specifically directed to *Figure 1* of Takahashi:

[T]he image formed by the relay lens 6 is not inside the operation/holding section 3. As noted above, in Fig. 1 of Takahashi, the relay lens 6 is in the insertion section 2 and the image of an object is formed in the last lens of the relay lens. Further, while Lens 9a (or 9b) forms an image of the image on the CCD 11a (or 11b), these lenses correspond to the imaging optical system in claim 1, and are not a part of the relay optical system.

Accordingly, it is submitted that Takahashi fails to disclose or fairly suggest the feature of claim 1 regarding *the relayed image is formed between the relay optical system and the imaging optical system in the camera head*.

⁵ Appeal Brief filed March 27, 2007.

(Br. 8.) The identical argument appears at page 4 of the Reply Brief. Figure 2 of Takahashi is not mentioned in the Brief or the Reply Brief. The Examiner cannot be faulted for failing to consider an argument that was not made in the Brief or the Reply Brief.

Appellants' reliance on the discussion of Takahashi's Figure 2 during the oral hearing is misplaced because "[a]ny arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown," 37 C.F.R. § 41.37(c)(1)(vii) (2009), and such good cause has not been alleged, let alone demonstrated. *See also* MPEP § 1205.02 (8th ed., rev. 7, July 2008) ("[A]rguments not presented in the brief or reply brief and made for the first time at the oral hearing are not normally entitled to consideration." (citing *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980))); *Rosenblum v. Hiroshima*, 220 USPQ 383, 384 (Comm'r Pat. 1983) ("The purpose of oral argument at final hearing is to emphasize and clarify written argument in the brief.").

For the foregoing reasons, the Request is denied to the extent that Appellants seek a change in our decision affirming the Examiner's § 103(a) rejection of claims 1 and 6-18 for obviousness over Igarashi '232 in view of Takahashi.

We note that the Request does not separately argue the § 103(a) rejection of claims 2-5, which is based on Igarashi '232 in view of Takahashi and Igarashi '634.

B. Discussion of Appellants' arguments regarding the new ground of rejection

At pages 16-19 of the Decision, we provided two alternative rationales in support of the conclusion that it would have been obvious to implement the rotatable connection between insertion section 2a and insertion section 2b in Takahashi's Figure 14 embodiment as a detachable connection.

1. The first rationale -- obviousness based on Takahashi alone

The first rationale given by the panel for making the connection between Takahashi's insertion sections 2a and 2b detachable as well as rotatable is that

such detachability would have been recognized as advantageous in that it would permit replacement of either inserting section 2a or the combination of inserting section 2b and operating/holding section 3 in the event of failure of one of those components. *See Perfect Web Tech., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) (“[W]hile an analysis of obviousness always depends on evidence that supports the required *Graham* [*v. John Deere Co.*, 383 U.S. 1 (1966)] factual findings, it also may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion.”).

(Decision 17.) In addition to relying on “common sense” as the motivation for modifying Takahashi in this manner, we found that such a modification would have been within the level of ordinary skill, noting the absence from Appellants' Application of any construction details concerning how to implement the detachable and rotatable connection between front-end insertion section 100 (Fig. 3) and camera head 500. *See* Decision 17 (“As

evidenced by the absence of any construction details in their Application, Appellants considered construction of a detachable and rotatable connection between the insertion sections to be within the level of ordinary skill in the art.”).

Appellants argue that “the BPAI comments regarding ‘common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion’ appears to be unsupported speculation and just a disguise for relying on the disclosure of the present specification, which constitutes inexpressible [sic: impermissible] hindsight.” (Request 7.) We remain of the view that a person having ordinary skill in the art, without the benefit of a specific teaching reference or Appellants’ application, would have considered it advantageous to make Takahashi’s rotatably connected components 2a and 2b detachable from each in order to permit replacement of a damaged component. Furthermore, we believe this conclusion is sound even though, as pointed out in the Request and acknowledged in the Decision, Takahashi’s disclosure of detachability is limited to the embodiments depicted in Figures 19(a) and 19(b), which are not relied on by the panel.⁶

⁶ As noted at pages 16-17 of the Decision, each of the embodiments depicted in Takahashi’s Figures 19(a) and 19(b) has a single inserting section 46 that is detachably connected to an operating/holding section 47 (col. 3, ll. 60-67; col. 11, ll. 35-37). More particularly, as explained at page 6 of the Request, cover member 47a is detachably connected to holding section body 47b (col. 10, l. 66–col. 11, l. 2).

Regarding our finding that the Application fails to provide details of how to construct the detachable and rotatable connection, Appellants argue that

[h]ere again, the BPAI's position seems to lacking, since the present specification indicates in paragraph [0051] that "the third relay lens 2-3 is formed substantially as a telecentric optical system to provide a parallelized light beam at a connection portion of the front-end insertion section and the camera head."

That is, forming the third relay lens 2-3 substantially as a telecentric optical system to provide a parallelized light beam at a connection portion of the front-end insertion section and the camera head would certainly qualify as evidence of construction details. Additionally, it is submitted that the present specification is replete with other construction details.

(Request 7.) We agree that the optical characteristics described and depicted in Appellants' Application can be characterized as construction details. However, the Application fails to disclose the details of the *mechanical* connection that permits the front-end insertion section 100 and the camera head 500 to be rotatable and detachable with respect to each other. The absence of such construction details supports our finding that such details were within the level of ordinary skill in the art.

2. *The second rationale -- obviousness based on Takahashi in view of Igarashi '232*

The panel, relying on Takahashi's explanation of how to use the Figure 14 embodiment, Igarashi '232's sterilizing cover 8 (Figure 4, reproduced at page 19 of the Decision), and Igarashi '232's disclosure of

detaching and discarding insert section 1 after it has been contaminated, concluded that it would have been obvious to form the rotatable connection between insertion section 2a and insertion section 2b of Takahashi's

Figure 14 embodiment as a detachable connection in order to allow replacement of inserting section 2a after use and contamination. Decision at 17-19. Appellants argue that

neither Takahashi ('948) nor Igarashi ('232) teach[es] or suggest[s] detaching a[] front-end insertion section from a camera head within a relay optical system. That is, the non-flexible endoscope shown in Fig. 4 of Igarashi ('232) does not even include a relay lens system, (col. 8, lines 52-55), and in the stereoscopic rigid-type endoscopes shown in Figs. 19(a) and 19(b) of Takahashi ('948) the relay optical systems 44a and 44b are included in the inserting section 46 and only the cover member 47a and the holding section body 47b of the operating/holding section 47 are detachable from one another.

(Request 6.) While these observations regarding Figure 4 of Igarashi '232 and Figures 19(a) and 19(b) of Takahashi are correct, they are not responsive to the panel's second rationale, which relies on Figure 14 of Takahashi in combination with Igarashi '232.

For the foregoing reasons, the Request is also denied to the extent that Appellants seek a change in our decision to enter a new ground of rejection of claim 1 under 35 U.S.C. § 103(a) for obviousness over Takahashi in view of Igarashi '232.

DECISION

The Request for Rehearing has been considered and is denied.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(v) (2000).

DENIED

babc

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